

REMARKS

Initially filed were claims 1-10. Based on the first office action dated 25 July 2001, the applicants, on 24 Jan. 2002, canceled claims 2 and 5 and amended certain others. In response to the final office action, the applicants canceled claims 1-10, and submitted new claims 11-19. Although claims 12 and 15 were added, they are now canceled immediately. The substance of claim 12 was added to claim 11.

Now pending are claims 11, 13, 14, 16, 17, 18, 19, of which claims 11, 13, 16, and 18 are independent. The claims are individually argued, do not stand or fall together, and are argued to further complete the record for appeal.

Claim 11

The applicants amended claim 11 to correct typographical errors by including an "I" where appropriate. No subject matter is intended to be surrendered as it clear that the amendment is simply a cosmetic change.

The examiner asserts that it would be routine to experiment with the Juda species to arrive at the claim 11 compound. First the applicants note that any insecticide artisan experimenting around with the insecticide would not pick the worst insecticide of the group to begin experimenting with and thus arrive at the instantly claimed compound. As the activity scores in Juda clearly show, of the phenanthrolines, the one species the examiner chose (the 2,9 dimethyl diphenyl) is the worst insecticide of the group. In fact, the ordinary artisan would be motivated to not experiment with the diphenyl compounds, but with the non-diphenyl ones because they show at least a two-time to almost 5 time increase in activity (scores 35 to 148). So, if the task before the insecticide artisan is to experiment around (presumably with the intent to make the insecticide better), then common sense dictates that the artisan would pick one that is

shown to work well and make it work better. An ordinary artisan intending to make an insecticide work better would not pick the worst one with the wholly speculative nature that one compound of the same general chemistry would work. Given that selection criteria, the artisan would pick the one that is known to work. Here, the compounds that exhibit the best activity are the compounds with the more “simpler” chemistry configurations. Then to say that one could easily (and would be suggested or motivated to do so nonetheless) take the simpler compound and then experiment with the myriad of groups that can be added to arrive at the claimed invention, is simply conjecture and wholly speculative. In fact, the activity indices clearly show that increasing activity is achieved using dimethyls as a base rather than omitting the dimethyls.

It is simply not enough to look at a bunch of chemicals listed in a table and then simply pluck one from the table, assert that it can be easily modified, and then say that modification was well within the skill of the artisan. This requires proof proffered by the Examiner.

The examiner also asserts that the burden is on the applicants to assert operability. This is not what the applicants are suggesting. Rather the applicants point out that the Examiner bears the burden of showing with scientific facts that the proposed chemical modification would be well within the skill of the ordinary artisan, not that the chemical modification be operable or not. The examiner cited stock MPEP language (which is inapplicable to this case) that the reference is operable. On closer scrutiny, this MPEP language actually means that when a reference teaches a chemical, such as the dimethyl diphenyl of example 27, it is presumed to be operable as the insecticide for which it was designed to do. The applicants do not quibble with whether it works as an insecticide because the reference teaches that it works but in fact does not work very well at all. Rather, the applicants argue that there is simply no suggestion that modifying that dimethyl diphenyl to the claim 11 compound would still result in an insecticide

that works. Then taking it one step further, then what is the motivation to use that claim 11 compound in the electronics field? The applicants assert that the Examiner bears the burden of proving with facts that: the proposed modification of the dimethyl diphenyl into the claim 11 compound would result in an operable insecticide. Rather the evidence suggests that modifying the dimethyl diphenyl by getting rid of the dimethyl portion would actually result in a worse insecticide because the Examples clearly show that the dimethyl contributes to increased activity. The examiner bears this burden of overcoming this teaching away with facts.

To reiterate, the applicants request an affidavit from the examiner under Rule 1.104(d)(2) that describes with the necessary scientific facts that:

- the disclosure of the 2,9 dimethyl diphenyl (example 27) is capable of being easily modified into the claim 11 compound;
- that this modification is within the skill of the art;
- that the modification would not render the claim 11 invention inoperable as an insecticide;
- and the motivation to make such a modification when the examples indicate that dimethyl is desirable for increased activity and that removing dimethyl would still result in a desirable insecticide.

To the extent that the examiner is taking official notice of any facts, the Examiner must apply these facts or specific data directly to the language of each claim to make out a prima facie case of obviousness. Because the Examiner has not applied these facts directly to the language of each claim, the Examiner has not made a prima facie case of obviousness by taking official notice. Moreover, the court construes a judicial notice of facts narrowly “and will regard facts

found in such manner with eye toward narrowing the scope of any conclusions to be drawn therefrom.” Because the claimed language and the art are facts that are in question and disputed by the Examiner, these facts are not “capable of instant and unquestionable demonstration as to defy dispute” as required by the court for “judicial notice” to be taken by the Examiner.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection to the claims. Furthermore, to preserve Applicants’ argument on appeal, Applicants re-request that the Examiner provide an affidavit that supports the rejection of the claims based on the official notice or personal knowledge of the Examiner. See *In re Lee*, 277 F.3d 13338, 1344-45, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on “common knowledge and common sense” did not fulfill the PTO’s obligation to cite references to support its conclusions as PTO must document its reasonings on the record to allow accountability and effective appellate review.)

Claim 13:

Claim 13 claims a bathophenanthroline compound having the claimed chemical structure. As with any preamble, the preamble sets out the environment in which the chemical can be used. The intended use, because it does not add any patentable weight, does not therefore constitute a new invention for the purposes of any restriction. The claims still call for chemical compositions. But simply for the sake of clarity the applicants are amending the claim. The claim is also amended to insert the “l” inadvertently omitted as a typographical, cosmetic error.

Claim 14:

Claim 14 is now allowed as it was not substantively rejected. The amendment to base claim 13 cleared up the indefiniteness issue.

Claim 16.

Claim 16 claims a pure process claim. There is no need to identify what is being made. The claims are directed to methods, not product claims, nor product made by the process claims. Therefore, the product made by the process is not required because that product is not being claimed. Here now there can be no doubt that process claims are being stated. The examiner asserts, however, that such identification of an end product is necessary. The examiner asserts no support for such an assertion. It is well established that the very reason method claims do not identify end products is because the end product is irrelevant to the method claim analysis. For example, a common or old product is not patentable itself but the process of making that old product can be patentable. In fact, there may be many patentable methods of making old products. The emphasis is on the method, not the product being made. In this case, the applicants initially presented the end product (the chemical) and the examiner asserted that the claim was therefore a method of making (product by process) claim and thus used the fact that the product was taught in the art to reject the method steps. So the applicant deleted such reference to the product to ensure that only the method was examined and the examiner asserts that the end product must be recited.

The applicants requests that the examiner point out to the proper Rule or MPEP section that clearly states that, “just listing some steps without reciting the end product itself is indefinite in scope” because then thousands of patents would be indefinite. For example, issued US patent 6,516,229 includes a method claim to irradiating a body: “6. A method for irradiating a portion of a human body, comprising: ...” Obviously it does not recite the end product, namely an irradiated human body. See also, Patent No. 6,516,217, claim 7 (“A fluorescence diagnosis method comprising...”) that apparently is indefinite because it fails to recite the end product

being the diagnosis. But if the Examiner cannot point to an MPEP section or Rule that clearly states her assertion, then the applicants request a second affidavit under Rule 1.104(d)(2) that not only specifies the grounds for the assertion, but also includes references to any OG, Commissioner Decision, Office of the Solicitor Memorandum, etc., that so explains.

As for any substantive rejection, the examiner has failed to show that the method steps claimed are found in Sugihara. Claim 16 calls for specific steps, none of which are taught. The examiner appears to rest the entire rejection on the fact that ultimate compounds made are somehow mysteriously made by the precisely claimed steps. Of course that is totally the wrong analysis because the prior art, when examining method steps, must show the method steps. See MPEP 2112.02. Simply recanting the end product made does not at all reveal the method in which it was made.

Claim 17:

Sugihara fails to teach the process limitation of claim 17. Nothing in Sugihara teaches carbanion formation and nucleophilic reactions. The examiner has simply cited to end products that could be formed, but has failed to show the process in which that end product is formed. It is the process that matters, not the end product formed that does. To preempt any other argument, if the examiner contends that an ordinary artisan would understand that the Sugihara disclosure teaches somehow the formation process or that the formation process would be within the general skill, the applicants reiterate a demand for a Rule 1.104(d)(2) affidavit that specifically points out the reaction pathways, copies from applicable textbooks of organic chemistry, etc., so that the record is complete for appeal.

Claim 18:

The applicants repeat the arguments made above regarding each point of the Office Action. In particular, the applicants also note that the process is not shown in Sugihara at all. Again all the examiner has done is simply show an end product (moiety #14) formed, but fails to show the process.

Claim 19:

The applicants repeat the arguments here. Again missing is any discussion of carbanion formation or nucleophilic reactions. Again, the applicants demand an affidavit under Rule 1.104(d)

The applicants restate the arguments made in the first office action response and include them here to the extent necessary.

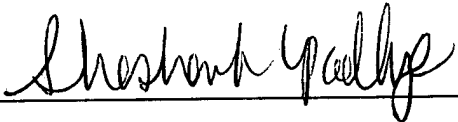
CONCLUSION

Applicants request prompt and favorable consideration of the claims. As always, if the Examiner desires a telephone interview to expedite prosecution, the undersigned may be reached at 312-876-2622.

Respectfully submitted,

SONNENSCHN NATH & ROSENTHAL

13 Feb. 2003

By: 

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I hereby certify that this document and any being referred to as attached or enclosed is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on

Date